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Paper No. 6

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APR 19 2002

In re Application of
Vyakarnam, et al.
Application No. 09/938,364
Deposited: August 24, 2001
Filing Date: January 2, 2002
Attorney Docket No. ETH1595

:
: **OFFICE OF PETITIONS**
: DECISION ON
: PETITION
:
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This is a decision on (1) the petition filed January 2, 2002 (certificate of mailing date November 14, 2001), requesting that the above-identified application be accorded a filing date of August 24, 2001 and (2) the petition for acceptance of photographs, both black and white and color.

The petition to accord an August 24, 2001 filing date is dismissed.

The petition to accept black and white and color photographs is granted.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

PETITION FOR FILING DATE OF AUGUST 24, 2001

The application was deposited on August 24, 2001. However, on September 14, 2001, the Office of Initial Patent Examination mailed a "Notice" requiring drawings of applicants' invention in compliance with 35 U.S.C. 113 and stating that the filing date would be the date of receipt of the omitted drawings. It is noted that the specification describes Figures 1,2,3,4,5,6,7A,7B,8,9A, 9B,9C,10,11,12, and 13.

In response, on January 2, 2002 (certificate of mailing date November 14, 2001), fifteen (15) sheets of drawings containing Figures 1-13 as listed above and the present petition were filed. Petitioners argue that 15 sheets of drawings containing Figures 1-13 as listed above were filed on August 24, 2001, and that the sheets of drawings containing Figures 1-13 as listed above must have been misplaced in the Patent and Trademark Office (PTO). In support, the petition is accompanied by declarations of Ms. Karen Hall-Morgan, Patent Paralegal for Johnson and Johnson and an itemized post card receipt showing 15 sheets of drawings were part of the application on August 24, 2001.

Ms. Hall-Morgan states that on August 24, 2001, she placed the application, including 15 sheets of drawings into Express Mail.

The evidence has been considered, but is not persuasive that the 15 sheets of drawings were filed on August 24, 2001. The PTO file is the official record of the papers originally filed in this application. A review of the official file reveals that no drawings were filed on August 24, 2001, since no such drawings are present in the file. An applicant alleging that a paper was filed in the PTO and later misplaced has the burden of proving the allegation by a preponderance of the evidence. The declaration relied on contain the declarant's recall of routine events which occurred over 2 months earlier and is not more persuasive than the record of what was filed as shown by the official file.

Further, Petitioner is advised that the provisions of 37 CFR 1.10(e) cannot be utilized to prove the contents of a mailing. MPEP 513 states, "Where there is a dispute as to the contents of correspondence submitted to the Office,...an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s)... were filed in the Office with such correspondence. Even if the "date-in" on Express Mail receipt label no. EL691435329US were filled in, it would not impact the analysis at hand. Rather, where the records of the Office (e.g. the file of the application) contain any document(s)... corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP 503 containing specific itemization of the document(s)... purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s)...that is not among the official records of the Office."

The best evidence of what was filed on August 24, 2001, is applicants' postcard receipt. A date stamped return postcard constitutes *prima facie* evidence that the application was filed on the date that is stamped on the postcard. MPEP 503. In this case, unfortunately, the itemized postcard in this case was not date stamped.

The request for an August 24, 2001 filing date is dismissed. The filing date, as of now, is January 2, 2002, which is the date of receipt in the Office of the drawings required by 35 U.S.C. 113, first sentence.¹

Pursuant to petitioners' authorization, deposit account no. 10-0750 will be charged the \$130.00 petition fee associated with a petition under 37 CFR 1.53(e)(2).

If petitioner is unable to provide a date stamped itemized postcard receipt, petitioner is urged to file a petition under 37 CFR 1.182. A review of the file confirms that the transmittal letter deposited on August 24, 2001, incorporated by reference the entire disclosure of prior application No. 09/469,118. The entire disclosure, including the drawings of application No. 09/469,118 was specifically incorporated by reference in the present application on August 24, 2001.

If the drawings supplied on January 2, 2002, are a part of the disclosure of application No. 09/469,118, then the drawings would have been present in the Office on August 24, 2001, albeit in the file of another application, i.e., application No. 09/469,118. Petitioner has not represented that the drawings supplied on January 2, 2002 are copies of the drawings filed in application No.

¹ November 14, 2001, the certificate of mailing date, cannot be relied upon to obtain a filing date.

09/469,118.

A petition under 37 CFR 1.182 and the required petition fee, including an amendment submitting the necessary omitted material (the drawing figures), requesting that the necessary omitted material contained in the prior application and submitted in the amendment, be included in the continuation or divisional application based upon the incorporation by reference statement, is required in order to accord the application a filing date as of the date of deposit of the continuation or divisional application. An amendment submitting the omitted material and relying upon the incorporation by reference will not be entered in the continuation or divisional application unless a decision granting the petition states that the application is accorded a filing date and that the amendment will be entered.

PETITION FOR ACCEPTANCE OF PHOTOGRAPHS

Regarding the black and white photographs, petitioners have stated that the photographs are the only practicable medium for illustrating the claimed invention.

Regarding the color photographs, a grantable petition under 37 CFR § 1.84(b)(2) must be accompanied by the fee set forth under 37 CFR § 1.17(h), 3 (three) sets of the color photographs in question, and the specification must contain, or be amended to contain, the following language as the first paragraph in that portion of the specification relating to the brief description of the drawings:

"The file of this patent contains at least one photograph executed in color. Copies of this patent with color photograph(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee."

Pursuant to petitioners' authorization, deposit account no. 10-0750 will be charged the \$130.00 petition fee. The petition was filed with the required fee and 3 (three) sets of color photographs of figures 10 and 11. The requested amendment to the specification contains the language required under 1.84 (a)(2)(I).

The petition to accept photographs, both black and white and color, is **GRANTED**.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of January 2, 2002, using the 15 sheets of drawings submitted with the instant petition on January 2, 2002. Thereafter, the application file will be forwarded to Drafting Division, Drawing Review Branch for review of the drawing figures in light of this decision.

Further correspondence with respect to this matter should be addressed as follows:

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
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Attn: E. Shirene Willis

Any inquiries pertaining to this matter may be directed to Petitions Attorney E. Shirene Willis at (703) 308-6712.

By Mr. Flanagan

Beverly M. Flanagan
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